

ESTTA Tracking number: **ESTTA469008**

Filing date: **04/25/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

### Opposers Information

Name	Marvel Characters, Inc.
Granted to Date of previous extension	04/25/2012
Address	1600 Rosecrans Avenue Manhattan Beach, CA 90266 UNITED STATES

Name	DC Comics
Granted to Date of previous extension	04/25/2012
Address	1700 Broadway New York, NY 10004 UNITED STATES

Attorney information	Jonathan D. Reichman, Esq. Kenyon and Kenyon LLP One Broadway New York, NY 10004 UNITED STATES tmdocketny@kenyon.com Phone:212-425-7200
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### Applicant Information

Application No	85382804	Publication date	12/27/2011
Opposition Filing Date	04/25/2012	Opposition Period Ends	04/25/2012
Applicant	Tanous, Gregory 2225 C Street Forest Grove, OR 97116 UNITED STATES		

### Goods/Services Affected by Opposition

Class 028. First Use: 2009/08/10 First Use In Commerce: 2009/08/10  
All goods and services in the class are opposed, namely: Remote control toys, namely, aircraft; Toy gliders

### Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	825835	Application Date	04/12/1966
Registration Date	03/14/1967	Foreign Priority Date	NONE
Word Mark	SUPER HERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1965/10/29 First Use In Commerce: 1966/03/04 MASQUERADE COSTUMES		

U.S. Registration No.	1140452	Application Date	01/24/1974
Registration Date	10/14/1980	Foreign Priority Date	NONE
Word Mark	SUPER HEROES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1973/07/02 First Use In Commerce: 1973/07/02 Toy Figures		

U.S. Registration No.	1179067	Application Date	07/03/1979
Registration Date	11/24/1981	Foreign Priority Date	NONE
Word Mark	SUPER HEROES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1966/10/00 First Use In Commerce: 1966/10/00 PUBLICATIONS, PARTICULARLY COMIC BOOKS AND MAGAZINES AND STORIES IN ILLUSTRATED FORM ((( ; CARDBOARD STAND-UP FIGURES; PLAYING CARDS; PAPER IRON-ON TRANSFER; ERASERS; PENCIL SHARPENERS; PENCILS; GLUE FOR OFFICE AND HOME USE, SUCH AS IS SOLD AS STATIONERY SUPPLY; NOTEBOOKS AND STAMP ALBUMS )) ]		

U.S. Registration No.	3674448	Application Date	01/23/2004
Registration Date	08/25/2009	Foreign Priority Date	NONE
Word Mark	SUPER HEROES		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 025. First use: First Use: 2005/01/01 First Use In Commerce: 2005/01/01 t-shirts
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Attachments	78356610#TMSN.gif ( 1 page )( bytes ) Notice of Opposition - RCSUPERHERO.pdf ( 7 pages )(6357023 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jonathan D. Reichman/
Name	Jonathan D. Reichman, Esq.
Date	04/25/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of : Gregory Tanous  
Serial No. : 85/382,804  
Filed : July 27, 2011  
For : RCSUPERHERO  
Published Official Gazette : December 27, 2011

-----X  
DC COMICS and :  
MARVEL CHARACTERS, INC., :  
 :  
Opposers, :  
 :  
vs. :  
 :  
GREGORY TANOUS, :  
 :  
Applicant. :  
-----X

Opposition No. \_\_\_\_\_

NOTICE OF OPPOSITION

DC Comics, a New York general partnership having a place of business at 1700 Broadway, New York, New York 10019, and Marvel Characters, Inc. ("Marvel"), a Delaware corporation having a place of business at 1600 Rosecrans Avenue, Manhattan Beach, California 90266 (collectively, "Opposer"), believe that they will be damaged by registration of the above-identified mark, and hereby oppose the registration of said mark. The grounds of opposition are as follows:

1. By the application herein opposed, Gregory Tanous ("Applicant") is seeking to obtain, under the provisions of the Trademark Act of 1946 (15 U.S.C. § 1051 *et seq.*), registration for the mark "RCSUPERHERO" for "remote control toys, namely, aircraft; toy gliders." Applicant filed the application on July 27, 2011.

2. Applicant has claimed use of the mark in commerce under Trademark Act Section 1(a) (15 U.S.C. §1051(a)).

3. Applicant alleges that his “first use” and “first use in commerce” of the “RCSUPERHERO” mark commenced on August 10, 2009.

4. Opposer is engaged in the businesses of, *inter alia*, entertainment, media, publishing, and merchandise licensing. Opposer DC Comics is the owner and publisher of “DC Comics” and related intellectual property, which feature such world-famous characters and properties as “SUPERMAN<sup>®</sup>” and “BATMAN<sup>®</sup>.” Opposer Marvel (including its related companies) is the owner and publisher of “Marvel Comics” and related intellectual property, which feature such world-famous characters and properties as “SPIDER-MAN<sup>®</sup>” and “IRON MAN.<sup>®</sup>”

5. Opposers are the joint owners of the trademarks and service marks “SUPER HERO,<sup>®</sup>” “SUPER HEROES<sup>®</sup>” and variations thereof. Beginning at least as early as 1958, *i.e.*, well prior to Applicant’s alleged first use dates, Opposer (including its predecessors-in-interest) has used “SUPER HERO,<sup>®</sup>” “SUPER HEROES<sup>®</sup>” and variations thereof as trademarks and service marks for a wide variety of products and services, including, without limitation, comic books, toys, games, clothing, television programming, motion pictures, internet entertainment, and foods.

6. Opposer is the owner of numerous registrations on the Principal Register of the United States Patent and Trademark Office for its marks “SUPER HERO,<sup>®</sup>” “SUPER HEROES<sup>®</sup>” and variations thereof, including without limitation the following:

<u>Mark</u>	<u>Reg. No.</u>	<u>Date of Reg.</u>	<u>Goods/ Services</u>
SUPER HERO	825,835	3/14/67	masquerade costumes
SUPER HEROES	1,140,452	10/14/80	toy figures

<u>Mark</u>	<u>Reg. No.</u>	<u>Date of Reg.</u>	<u>Goods/ Services</u>
SUPER HEROES	1,179,067	11/24/81	publications, particularly comic books and magazines and stories in illustrated form; notebooks and stamp albums
SUPER HEROES	3,674,448	8/25/09	t-shirts

Most of these registrations issued prior to Applicant's alleged first use dates, and consequently there is no question of priority of rights, such priority clearly belonging to Opposer. Moreover, most of these registrations are incontestable under 15 U.S.C. § 1065.

7. Through Opposer's activities, and through the extensive promotion and advertising of Opposer and its licensees connected therewith, the public and trade have come to associate the trademarks and service marks "SUPER HERO,<sup>®</sup>" "SUPER HEROES<sup>®</sup>" and variations thereof with Opposer, and with its products and services.

8. By virtue of its prior use in commerce of "SUPER HERO,<sup>®</sup>" "SUPER HEROES<sup>®</sup>" and variations thereof, Opposer is entitled to hold itself out to the public and trade as having the exclusive right to use "SUPER HERO,<sup>®</sup>" "SUPER HEROES<sup>®</sup>" and variations thereof as trademarks and service marks for its products and services. Registration of the applied-for mark would be inconsistent with such right of Opposer.

9. Substantial efforts have been made by Opposer and its licensees to advertise and promote their goods and services under Opposer's "SUPER HERO<sup>®</sup>" and "SUPER HEROES<sup>®</sup>" trademarks and service marks. Opposer, by its aforesaid use of "SUPER HERO,<sup>®</sup>" "SUPER HEROES<sup>®</sup>" and variations thereof, and by its promotional efforts in connection therewith, has built up valuable goodwill associated with these marks. As a result of their long use, advertising

and promotion by Opposer, such marks have acquired secondary meaning in the minds of both the trade and public in connection with Opposer and with its products and services.

10. If Applicant is granted registration for the mark opposed herein, he would obtain thereby at least the *prima facie* exclusive right to use such mark. Such registration would be a significant source of damage and injury to Opposer.

11. Registration should be denied under Lanham Act Section 2(d) (15 U.S.C. § 1052(d)), because Applicant's applied-for mark is confusingly similar to Opposer's "SUPER HERO<sup>®</sup>" and "SUPER HEROES<sup>®</sup>" trademarks and service marks, as it incorporates Opposer's "SUPER HERO<sup>®</sup>" trademark in its entirety.

12. Moreover, Applicant's mark is allegedly being used in connection with goods which are similar and/or related to goods and/or services with which Opposer has used and/or registered its "SUPER HERO<sup>®</sup>" and "SUPER HEROES<sup>®</sup>" marks, as well as many of its other marks. As a result, Opposer holds rights in the terms "SUPER HERO<sup>®</sup>", "SUPER HEROES<sup>®</sup>" and variations thereof which are superior to Applicant's alleged rights with respect to the identified goods.

13. Applicant's use and registration of his mark is likely to cause injury to Opposer's rights in its "SUPER HERO<sup>®</sup>" and "SUPER HEROES<sup>®</sup>" marks, as such use and registration will inevitably cause confusion and mistake and will deceive the public into believing that Applicant's goods are affiliated with, sponsored by, or jointly developed with Opposer or Opposer's licensees, and that such goods emanate from the same source, and/or that Applicant is in some other fashion connected with Opposer, all to Opposer's injury.

14. If Applicant is permitted to register the applied-for mark so as to claim exclusive rights therein, confusion among the public and trade will result, causing damage and injury to



Opposer. Members of the trade and public familiar with Opposer's "SUPER HERO<sup>®</sup>" and "SUPER HEROES<sup>®</sup>" trademarks and service marks would be likely to believe (and would be justified in so believing) that Applicant's goods originate from Opposer, or an entity in some way associated with Opposer, or are licensed or authorized by Opposer or with Opposer's approval. Furthermore, any objection or fault found with Applicant's goods would necessarily reflect upon and seriously injure the reputation which Opposer has established in connection with the goods and services sold by Opposer and its licensees under the "SUPER HERO<sup>®</sup>" and "SUPER HEROES<sup>®</sup>" marks.

15. Consequently, the applied-for mark does not and cannot exclusively identify the goods of Applicant, nor can it distinguish those goods from the goods and services of Opposer, nor can it serve as an indication of source or origin of such goods.

16. By reason of the foregoing, Applicant's registration of the mark herein opposed will cause damage and injury to Opposer, and to Opposer's rights in its "SUPER HERO<sup>®</sup>" and "SUPER HEROES<sup>®</sup>" marks.

17. For the above reasons, Application Serial No. 85/382,804 should be denied registration under 15 U.S.C. § 1052(d).

18. The statutory fee of three hundred dollars (\$300.00), and any additional required fees, should be charged to the undersigned's Deposit Account No. 11-0600.

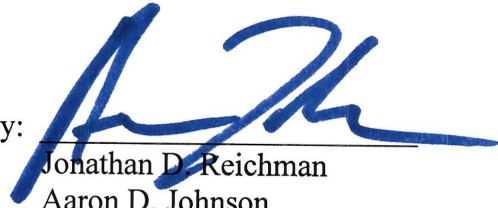


WHEREFORE, Opposer prays that Application Serial No. 85/382,804 be rejected, and that the registration of the mark be denied and refused, and that this Opposition be sustained.

KENYON & KENYON LLP

Dated: April 25, 2012

By:



Jonathan D. Reichman

Aaron D. Johnson

One Broadway

New York, New York 10004

Phone: (212) 425-7200

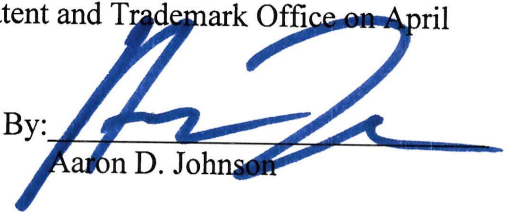
Fax: (212) 425-5288

*Attorneys for Opposers*

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being filed through the electronic system for the Trademark Trial and Appeal Board in the United States Patent and Trademark Office on April 25, 2012.

By:

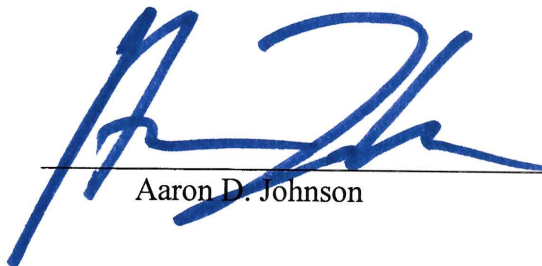


Aaron D. Johnson

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing document, entitled Notice of Opposition, was served on this 25th day of April, 2012, by first class mail, postage prepaid, upon Applicant at the following address:

Mr. Gregory Tanous  
2225 C Street  
Forest Grove, OR 97116-1631



Aaron D. Johnson